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SEP 04 2008

In re Application of Wang et al. :
Application No. 09/887,413 : Decision on Petition
Filing Date: June 21, 2001 :
Attorney Docket No. MS1-0752US :

This is a decision on the petition under 37 CFR 1.181 filed June 13, 2008, requesting the Office withdraw the holding of abandonment.

The petition is **granted**.

Facts:

On February 19, 2008, the Board of Appeals and Interferences issued a decision. The decision affirmed the Examiner's rejection of all the claims and entered a new ground of rejection for claims 35-42 under 35 U.S.C. § 101.

Quoting 37 CFR 41.50(b), the decision stated petitioner must take one of the following actions within two months in order to avoid termination of proceedings:

- (1) "Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both...."
- (2) "Request rehearing."

Petitioner filed an amendment on Monday, April 21, 2008. The amendment amends claims 1-5, 7-14, 16, 18-22, 24-26, 28, 30, and 32-42.

The Office mailed a Notice of Abandonment on May 13, 2008. The Notice stated the application was abandoned because the period for seeking review of the Board decision had expired and no claims had been allowed.

Discussion:

Section IV of MPEP 1214.06 states,

If the Board affirms the examiner's rejection, but also enters a new ground of rejection under 37 CFR 41.50(b), the subsequent procedure depends upon the action taken by the appellant with respect to the 37 CFR 41.50(b) rejection.

- (A) If the appellant elects to proceed before the examiner with regard to the new rejection (see MPEP § 1214.01, paragraph I) the Board's affirmance will be treated as nonfinal, and no request for rehearing of the affirmance need be filed at that time. Prosecution before the examiner of the 37 CFR 41.50(b) rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution. Therefore, it is possible for the application to be allowed as a result of the limited prosecution before the examiner of the 37 CFR 41.50(b) rejection.

The fact the examiner's rejection of all the claims was affirmed did not prohibit petitioner from complying with 37 CFR 41.50(b)(1), by filing an amendment, in order to avoid abandonment.

The April 21, 2008 amendment improperly seeks to amend claims that were not rejected based on 35 U.S.C. § 101. The Board *only* entered a new ground of rejection for claims 35-42. The amendment seeks to amend claims 1-5, 7-14, 16, 18-22, 24-26, 28, 30, and 32-42. Although the amendment improperly seeks to amend claims not falling within the new ground of rejection, the amendment also seeks to amend claims that do fall within the new ground of rejection.

Therefore, the timely filed amendment was sufficient to avoid abandonment of the application.

Technology Center Art Unit 2164 will be informed of the instant decision and the amendment filed April 21, 2008, will be examined in due course.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



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